

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	MOECKLY	Examiner:	P. WARTALOWICZ
Serial No.:	10/751,091	Group Art Unit:	1793
Filed:	JANUARY 2, 2004	Docket No.:	10467.43US12
Title:	HIGH-TEMPERATURE SUPERCONDUCTOR DEVICES AND METHODS OF FORMING THE SAME		

Electronically filed on 7 September 2010.

APPELLANT'S REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

This Brief is presented in reply to the Examiner's Answer mailed on 7 July 2010.

Applicants respectfully disagree with the Examiner's reading of *Abbott Laboratories v. Sandoz, Inc.*, 566 F.3d 1282 (Fed. Cir. 2009) (*en banc*) and its impact on *In re Thorpe*, 777 F.2d 695 (Fed. Cir. 1985). Ignoring the Federal Circuit's own admonition that patent claims are construed the same way for validity and for infringement (*Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1330 (Fed. Cir. 2003); *Amazon.com, Inc. v. Barnesandnoble.com, Inc.*, 239 F.3d 1343, 1351 (Fed. Cir. 2001)), the Examiner contends that the *Abbott* holding applies only to infringement and endorsing *Thorpe*. Examiner's Answer at 6-7. However, the *Abbott* Court quoted *Thorpe* only for the proposition that "product-by-process claims are limited by and defined by the process." *Abbott*, 566 F.3d at 1292 (emphasizing the above-quoted portion.) *See, also, id.* at 1293 ("As noted earlier, this holding follows this court's clear statement in *In re Thorpe* that 'product by process claims are limited by and defined by the process.'") Indeed, in her dissent, Judge Newman, joined by Judges Mayer and Lourie, characterized the *en banc* majority's position as to *Thorpe*: "My colleagues are mistaken in stating that *Thorpe* held that all such claims are to be construed as process claims, even when the

product is new and the rule of necessity justifies this mode of describing the invention.” *Abbott*, 566 F.3d at 1308.

Applicants therefore respectfully submit that the appealed claims of the present application should be interpreted with all limitations taken into consideration, including the process limitations.

Furthermore, the claim language that characterizes the “process” in the product-by-process claims also connotes structure that the *Hunt* references fail to disclose or suggest. For example, the limitation, “the first and third layers being formed from a starting oxide high-temperature superconductor layer of an oxide high-temperature superconductor, the third layer being an ion-modified portion of the starting oxide high-temperature superconductor layer, the first layer being an unmodified portion of the starting oxide high-temperature superconductor layer” in claim 65 not only describes the process by which the barrier and the first layer are made, but also requires a specific structural relationship between the two: The barrier and the first layer are native to each other. Similar limitations are present in all appealed claims and are missing from the *Hunt* references. The claimed devices are therefore distinguishable from the prior art both by the process of manufacture and by structure.

Applicants therefore respectfully submit that the appealed claims are not obvious over either the *Hunt* 1991 Article or *Hunt* Patent and discussed in the Applicants’ Appeal Brief.

SUMMARY

Applicants therefore respectfully request that the Examiner's rejection be reversed, and that all of the pending claims be allowed.



Date: 7 September 2010

Respectfully submitted,

MERCHANT & GOULD P.C.
P.O. Box 2903
Minneapolis, Minnesota 55402-0903
(612) 332-5300

/Tong Wu/

Tong Wu
Reg. No. 43,361
TW:cjc